

REMARKS

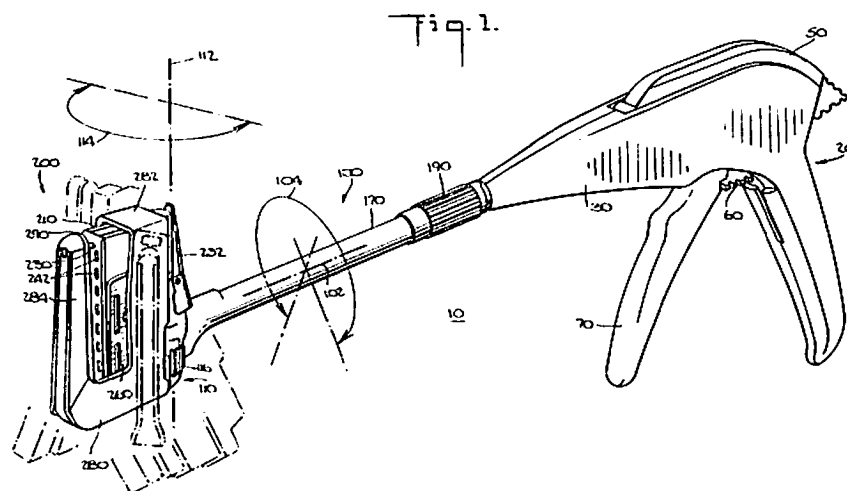
The above-identified application has been reviewed in light of the Office Action mailed on January 26, 2009. By the present amendment, the applicant has added new dependent claims 9 and 10. It is respectfully submitted that the claims pending in the application, namely claims 2-10, are fully supported by the specification, introduce no new matter, and are allowable over the cited references of record.

The Office Action rejected claims 2-8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,728,020 to Green et al. ("Green"). With regard to independent claims 2 and 8, the Office Action asserted that Green discloses an elongate member defining a longitudinal axis, a staple storage portion attached to a distal portion of the elongate member and being movable between two positions with respect to the longitudinal axis defined by the elongate member, a control member capable of rotating the elongate member about the longitudinal axis, and an advancing mechanism capable of advancing surgical fasteners through the staple storage portion and an anvil. The rejection of claims 2-8 is respectfully traversed.

Presently, claim 2 recites a surgical stapling apparatus including, *inter alia*, a staple storage portion attached to a distal portion of the elongated member, "the staple storage portion being movable throughout a plurality of positions including a first position that is substantially aligned with the longitudinal axis and a second position that is axially offset from the longitudinal axis," and "a control member spaced from the distal portion for rotating the elongate member about the longitudinal axis." Claim 2 further requires: "the control member being movable from a first position to a second position to effect movement of the staple storage portion from its first position to its second position." Not only does the control member rotate the elongate member about the longitudinal axis, but the control member is also movable from a first

position to a second position to effectuate the movement of the staple storage portion from its first position to its second position where the staple storage portion's second position is axially offset from the longitudinal axis.

On the other hand, Green relates to a surgical stapler having a fastener applying assembly 200 that is connected to an actuator assembly by a longitudinal shaft assembly 100. As shown below in FIG. 1, the fastener applying assembly 200 includes frame 280 and proximal fastener holding part 210, which is mounted on the distal end of shaft assembly 100 for rotation by hand about axis 112.



The surgeon changes the position of the fastener applying assembly 200 by hand. The locking ring 190 is utilized to secure the position of the fastener applying assembly 200 and does not result in a change in its position about axis 112. See col. 4, lines 16 through 25 and col. 6, line 52 through col. 7, line 33. As disclosed in Green, rotation of the locking ring 190 rotates the fastener applying assembly 200 about the longitudinal axis 102 and does not effect rotation of the fastener applying assembly 200 about axis 112 which transverse to the longitudinal axis 102. According to Green, manual manipulation of the fastener applying assembly 200 results in

rotation about axis 112.

Contrary to the position taken in the Office Action, Green does not disclose or suggest a “the staple storage portion being movable throughout a plurality of positions including a first position that is substantially aligned with the longitudinal axis and a second position that is axially offset from the longitudinal axis,” and “a control member spaced from the distal portion for rotating the elongate member about the longitudinal axis, the control member being movable from a first position to a second position to effect movement of the staple storage portion from its first position to its second position” as recited in claim 2. As shown above in FIG. 1, locking ring 190 is merely configured to rotate shaft assembly 100 about axis 102. Locking ring 190 is not configured to move “from a first position to a second position to effect movement of the staple storage portion from its first position to its second position” where the staple storage portion’s second position is “axially offset from the longitudinal axis” as recited in claim 2. The only way to axially offset frame 280 in Green would be by grasping frame 280 and rotating it by hand about axis 112 within the limits indicated by the ends of double-headed arrow 114.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP 2131.01. However, the Office Action acknowledges that the device of Green may not perform the same function or in the same manner as applicant’s invention.

Specifically, the Office Action states “movement of the staple storage portion and/or rotation of the staple storage portion about the longitudinal axis has not been claimed as with respect to the proximal (handle portion) end of the stapler and therefore rotation of the entire stapler about the longitudinal axis anticipates the claim.” However, as discussed hereinabove,

independent claim 2 clearly recites that the control member can (1) rotate the elongate member about the longitudinal axis, and (2) move from a first position to a second position to effect movement of the staple storage portion from its first position to its second position where the staple storage portion's second position is axially offset from the longitudinal axis. The Office Action equates the locking tab in Green with the control member of the claimed apparatus. However, while locking tab can rotate the end effector about the longitudinal axis, it is not capable of moving from a first position to a second position to axially offset the end effector from the longitudinal axis.

Accordingly, it is respectfully submitted that independent claim 2 is not anticipated or suggested by Green. Further, since claims 3-7 depend from independent claim 2, it is respectfully submitted that these claims are also in condition for allowance. Therefore, it is respectfully requested that the rejection of claims 2-7 be withdrawn.

With regard to independent claim 8, as previously presented, claim 8 recites an apparatus including, *inter alia*, an elongated member defining a longitudinal axis, a staple storage portion movable throughout a plurality of positions, and a control member rotatable to effect rotation of the elongate member. Further, the control member is movable along the longitudinal axis from a first position to a second position to effect movement of the staple storage portion throughout a plurality of positions. As discussed hereinabove, the locking tab in Green, which the Office Action equates to the control member of the claimed apparatus, is only capable of rotational movement. Therefore, the locking tab of Green is not configured to be moveable "along the longitudinal axis" as recited in independent claim 8.

Accordingly, Green fails to disclose or suggest a rotatable control member for rotating the elongated member that is also capable of moving along the longitudinal axis to move the

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staple storage portion throughout a plurality of positions, as recited in independent claim 8.

Therefore, it is respectfully submitted that claim 8 is not anticipated or suggested by the references of record and that it is in condition for allowance.

Applicants have added new claims 9 and 10 for consideration. As discussed hereinabove, Green fails to anticipate or suggest the surgical stapling apparatus recited in independent claims 2 and 8. Since claim 9 depends from claim 2 and claim 10 depends from claim 8, it is respectfully submitted that claims 9 and 10 are also in condition for allowance.

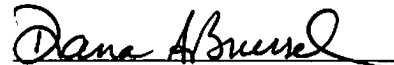
In view of the foregoing, it is respectfully submitted that all claims presently pending in the application, namely claims 2-10, are in condition for allowance. Should the Examiner believe that a telephone or personal interview may facilitate resolution of any remaining matters, the Examiner is respectfully requested to contact the Applicant's undersigned attorney at the telephone number indicated below.

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Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefore.

Respectfully submitted,

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